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EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,819

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The affidavit under 37 C.F.R § 1.131 filed 2/19/04 is insufficient to establish a conception of the invention prior to the effective date of the Karves reference. A conception of an invention, though evidenced by disclosure, drawings and even a model, is not a complete invention under patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, **UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT.**

Paragraph 3 of the declaration filed 2/19/2004 indicates the Applicant's application was assigned to Trop, Pruner & Hu, P.C. by Intel on September 28, 2001. Exhibit A filed 2/19/2004 specifies the invention was conceived August 1999. However Applicant fails to provide any evidence of diligence between August 1999 and September 28, 2001. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897) it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. Nonetheless, exhibit A filed 2/19/04 fails to show "obtaining information from the first system **if it is present in the first system**; searching at least one remote source for the information **if it is not present in the first system**" as claimed in the independent claims.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 9-12, 23-36, 31-33 and 37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gillespie, U.S. Patent Application Publication No. 2002/0137497 (hereinafter Gillespie).

Regarding claim 23, Gillespie discloses a method comprising receiving in a first system a search query for information associated with a second party during a telephone call; obtaining the information from the first system if it is present in the first system; searching at least one remote source for

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the information if it is not present in the first system and providing the information to the first system from the remote source (see Figure 3).

Regarding claim 24, see paragraph 0027.

Regarding claim 25, see Figure 3.

Regarding claim 26, see paragraph 0033.

Claim 31 is rejected for the same reasons as claim 23.

Claim 32 is rejected for the same reasons as claim 24.

Claim 33 is rejected for the same reasons as claim 26.

Regarding claim 9, see Figure 3 and paragraph 0027.

Regarding claim 10, see Figure 3 and paragraph 0027.

Regarding claim 11, see Figure 3 and paragraph 0027.

Regarding claim 12, see Figure 3 and paragraph 0027.

Regarding claim 37, see Figure 1.

4. Claims 9-12, 23-27, 30-34, 37 and 39 are rejected under 35 U.S.C. § 102(e) as being anticipated by Fleming III, U.S. Patent No. 6,697,484 (hereinafter Fleming).

Regarding claim 9, Fleming discloses a system comprising a processor; a storage associated with said processor to store a first database with a plurality of records, each containing a telephone number, a name and other information; and an application stored in said storage that enables said processor

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to access the telephone number of a second party to an ongoing call telephone call, search said first database for a record containing said telephone number, and display a name, telephone number and other information associated with said record (see Figures 1-5 and 11).

Regarding claim 10, see Figures 1-5 and 11.

Regarding claim 11, see Figures 1-5 and 11.

Regarding claim 12, see Figures 1-5 and 11.

Regarding claim 23, see Figures 1-5 and 11.

Regarding claim 24, see Figures 1-5 and 11.

Regarding claim 25, see Figures 1-5 and 11.

Regarding claim 26, see Figures 1-5 and 11.

Regarding claim 27, see Figures 1-5 and 11.

Regarding claim 30, see Figures 1-5 and 11.

Regarding claim 31, see Figures 1-5 and 11.

Regarding claim 32, see Figures 1-5 and 11.

Regarding claim 33, see Figures 1-5 and 11.

Regarding claim 34, see Figures 1-5 and 11.

Regarding claim 37, see Figures 1-5 and 11.

Regarding claim 39, see Figures 1-5 and 11.

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5. Claims 9-12, 23-26, 31-33 and 37 are rejected under 35 U.S.C. § 102(a) as being anticipated by Karves et al, European Patent Application No. 1,143,667 (hereinafter Karves).

Regarding claim 9, discloses a system comprising:

a processor (the claimed processor is located in wireless terminal taught by Karves. Karves teaches the wireless terminal may be any wireless device used for communication including but not limited to a wireless telephone, a PDA, a palm top device and a portable computer, see column 13);

a storage (local phonebook database located on wireless terminal, columns 7 and 14) associated with said processor to store a first database with a plurality of records, each containing a telephone number, a name and other information; and

an application (phonebook application, column 14) stored in said storage that enables said processor to access the telephone number of a second party to an ongoing telephone call, search said first database for a record containing said telephone number, and display a name, telephone number and other information associated with said record (see Figure 2 and column 14).

Regarding claim 10, see 205.

Regarding claim 11, see 205.

Regarding claim 12, see column 7.

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Regarding claim 23, Karves discloses a method comprising:
receiving in a first system a search query for information
associated with a second party during a telephone call (202);
obtaining the information from the first system if it is
present in the first system (204);
searching at least one remote source for the information if
it is not present in the first system (205);
providing the information to the first system from the
remote source (208).

Regarding claim 24, see 204.

Regarding claim 25, see column 7.

Regarding claim 26, see column 7.

Claim 31 is rejected for the same reasons as claim 23.

Claim 32 is rejected for the same reasons as claim 24.

Claim 33 is rejected for the same reasons as claim 26.

Regarding claim 37, see Figure 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which
forms the basis for all obviousness rejections set forth in this
Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Gillespie in view of Silverbrook et al, U.S. Patent No. 6,628,430 (hereinafter Silverbrook).

Regarding claim 38, Gillespie does not disclose a printer housed in the portable device. However Silverbrook discloses this limitation (see abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gillespie with the printer taught by Silverbrook. This modification allows a user to print as suggested by Silverbrook.

8. Claim 14 is rejected under 35 U.S.C § 103(a) as being unpatentable over Gillespie in view of Salimando, U.S. Patent No. 5,970,133 (hereinafter Salimando).

Regarding claim 14, Gillespie discloses said storage stores a sequential listing of caller identification information for incoming telephone calls (see Figure 3). Gillespie fails to disclose said storage stores a sequential listing of telephone numbers of outgoing telephone calls. However Salimando discloses

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this limitation (see Figure 2b). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gillespie with the storage taught by Salimando. This modification would allow users to avoid misdialing as taught by Salimando.

9. Claims 28 and 35 are rejected under 35 U.S.C § 103(a) as being unpatentable over Gillespie in view of McKnight, U.S. Patent Application Publication No. 2003/0063732 (hereinafter McKnight).

Regarding claim 28, Gillespie does not disclose storing the telephone call in a call history in the first system. However McKnight discloses this limitation (see paragraph 0014).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gillespie with the call history taught by McKnight. This modification allows for communications to be logged as suggested by McKnight.

Claim 35 is rejected for the same reasons as claim 28.

10. Claims 13, 29 and 36 are rejected under 35 U.S.C § 103(a) as being unpatentable over Gillespie.

Regarding claim 13 Gillespie fails to disclose said storage stores a user preference table that indicates a preferred search

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hierarchy among a plurality of databases. "Official Notice" is taken that this limitation is both old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gillespie with a user preference table. This modification would allow information to be obtained from a plurality of information sources as suggested by Gillespie.

Claim 29 is rejected for the same reasons as claim 13.

Claim 36 is rejected for the same reasons as claim 29.

11. Claim 30 is rejected under 35 U.S.C § 103(a) as being unpatentable over Gillespie in view of Vasa et al, U.S. Patent No. 6,324,396 (hereinafter Vasa).

Regarding claim 30, Gillespie discloses the plurality of remote sources includes a remote service provider (paragraph 0028). Gillespie does not disclose the plurality of remote sources includes the Internet. However Vasa discloses this limitation (see col. 2, lines 40-50 and col. 6, lines 35-40). Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Gillespie with the Internet as taught by Vasa. This modification allows for queries to be transmitted over various signal links as suggested by Vasa.

12. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Fleming in view of Silverbrook.

Regarding claim 38, Fleming does not disclose a printer housed in the portable device. However Silverbrook discloses this limitation (see abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming with the printer taught by Silverbrook. This modification allows a user to print as suggested by Silverbrook.

13. Claims 13, 29 and 36 are rejected under 35 U.S.C § 103(a) as being unpatentable over Fleming.

Regarding claim 13 Fleming fails to disclose said storage stores a user preference table that indicates a preferred search hierarchy among a plurality of databases. "Official Notice" is taken that this limitation is both old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming with a user preference table. This modification would allow information to be obtained from a plurality of information sources as suggested by Gillespie.

Claim 29 is rejected for the same reasons as claim 13.

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Claim 36 is rejected for the same reasons as claim 29.

14. Claims 14, 28 and 35 are rejected under 35 U.S.C § 103(a) as being unpatentable over Fleming in view of McKnight.

Regarding claim 14, Fleming does not disclose said storage stores a sequential listing of telephone numbers of outgoing calls and caller identification information for incoming calls. However McKnight discloses this limitation (see paragraph 0014). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming with the listing taught by McKnight. This modification allows for communications to be logged as suggested by McKnight.

Claim 28 is rejected for the same reasons as claim 14.

Claim 35 is rejected for the same reasons as claim 28.

15. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Karves.

Regarding claim 38, Karves discloses the portable device may be a computer. Karves does not disclose a printer housed in the portable device. "Official Notice" is taken that this limitation is both old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Karves a printer. This

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modification would allow for information to be printed as suggested by Karves (see Figure 1).

16. Claims 14, 28 and 35 are rejected under 35 U.S.C § 103(a) as being unpatentable over Karves in view of McKnight.

Regarding claim 14, Karves does not disclose the limitation of, "enabling the first system to store a sequential listing of telephone numbers of outgoing telephone calls and caller identification for incoming telephone calls". However McKnight discloses this limitation (paragraph 0014). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Karves with the storing system taught by McKnight. This modification allows for a list of terminating and originating calls to be stored as suggested by Karves (Figure 9) and McKnight.

Claim 28 is rejected for the same reasons as claim 8.

Claim 35 is rejected for the same reasons as claim 8.

17. Claims 13, 29, 30 and 36 are rejected under 35 U.S.C § 103(a) as being unpatentable over Karves in view of Szlam et al, U.S. Patent No. 5,675,637 (hereinafter Szlam).

With respect to claim 13, Karves does not disclose said storage stores a user preference table that indicates a

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preferred search hierarchy among a plurality of databases. However Szlam discloses this limitation (see column 16 and Figure 3). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Karves with the hierarchy taught by Szlam. This modification allows for a user to obtain desired information from a plurality of information sources quickly and automatically through a user customized application program as suggested by Szlam (column 5).

Claim 29 is rejected for the same reasons as claim 13.

Regarding claim 30, see Figure 1 of Karves.

Claim 36 is rejected for the same reasons as claim 29.

18. Claims 27, 34 and 39 are rejected under 35 U.S.C § 103(a) as being unpatentable over Karves in view of Littleton et al, U.S. Patent Application Publication No. 2003/0023759 (hereinafter Littleton).

Regarding claim 39, Karves does not disclose synchronizing data between the first database and a memory of the computer system. However Littleton discloses this limitation (paragraph 0004). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Karves with the synchronizing system taught by Littleton. This

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modification ensures the computer is updated with the latest updates as suggested by Littleton.

Claim 27 is rejected for the same reasons as claim 39.

Claim 34 is rejected for the same reasons as claim 27.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A.
Olisa Anwah
Patent Examiner
March 17, 2004

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SUPERVISORY PATENT EXAMINER
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